

Page 2

the electrode terminals, such that when the distal surface of the shield is adjacent to, or in contact with, tissue at a target site, the shield forms a chamber between the electrode terminals and the tissue.

Roos does not teach a device having a shield that forms a chamber between the electrode terminals and the tissue. With reference to Figures 7-9, Roos teaches a device having a cutting loop (or treatment electrode) 12, that extends past the distal end of the insulating rings 35, 37 located at the distal end of the device. Applicant also refers to Col. 7, lines 8-16 of the Roos patent, which teaches that “[i]t is also important in the case of the embodiments of FIGS. 7 and 8 that the cutting loop extends radially up to an insulating ring 35 mounted at the front on the neutral electrode 11 and can be retracted up to this. In this way, the front edge of the endoscope shaft, namely the front edge of the insulating ring 35 serves as a support for the cutting loop 12, so that the material is reliably removed therefrom. Therefore, as shown the insulating ring 35 must be rounded at the front.”

Clearly, Roos teaches a device which places tissue between the cutting loop 12 and the distal edge of the insulating ring to remove tissue. Contrary to applicant's invention, the cutting loop 12 of Roos extends distally past the front edge of the insulating ring 35. Roos absolutely fails to teach a device having a shield with a distal surface that is spaced distally from the electrode terminal and that forms a chamber between the electrode terminals and the tissue.

In view of the above, applicant believes that Roos does not anticipate claim 11 and respectfully requests withdrawal of this rejection.

35 U.S.C. §103

The Office Action rejected claims 12-20 under 35 U.S.C. §103(a) as being unpatentable over Roos. Without considering the merits of this rejection Applicant believes that the Office Action fails to establish a *prima facie* case of obviousness.

It is a well established rule of law that a proper *prima facie* case of obviousness requires that the cited reference teach or suggest all the claim limitations. As discussed above with regards to the 35 U.S.C. §102(b) rejection, Roos fails to teach or suggest all

Page 3

of the elements of claim 11. Accordingly, Roos fails to teach or suggest all of the elements of all claims ultimately dependent from claim 11.

In view of the above, applicant respectfully requests withdrawal of this rejection.

SUMMARY

Applicant believes all outstanding issue raised in the previous Office Action are addressed herein and that the claims are in condition for allowance. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at (408) 736-0224.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Sanjay S. Bagade", with a stylized flourish at the end.

Sanjay S. Bagade
Reg. No. 42,280

ArthroCare Corporation
680 Vaqueros Ave.
Sunnyvale, CA 94085-3523
(408) 736-0224